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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/697,755
Filing Date: October 30, 2003
Appellant(s): NOBUSAWA ET AL.

MAILED

FEB 26 2008

Technology Center 2600

Seth Weinfeld
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed Jan 28, 2008 appealing from the Office action mailed May 26, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,223,029	Stenman et al.	4-2001
6,078,270	Shim	6-2000
5,671,267	August et al.	9-1997

2003/0156053	Wall et al.	8-2003
5,410,326	Goldstein	4-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 16,19, 22,26, 29,32,36, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. and further in view of Shim (U. S. Patent No. 6,078,270).

Referring to claims 16, 26 and 36, Stenman et al. teaches a mobile telephone with remote-controlling capability which remote-controls target equipment (Column 3, Lines 22-29 and Column 7, Lines 56-63) comprising: storage means for storing a group of remote control codes for a predetermined controlling operation on the target equipment (Column 3, Lines 30-33 and Column 7, Lines 56-63); and transmission means for transmitting to the target equipment remote control codes in response to a user operation (Column 7, Lines 49-51), Stenman et al. further teaches remotely

controlling such devices as TV/VCR (Column 7, Lines 15-21) but does not specifically teach transmitting a group of remote control codes stored in the storage means in response to a user operation. Shim teaches transmitting a group of remote control codes stored in the storage means in response to a user operation (Column 1, Lines 32-58). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al. with the teaching of Shim of transmitting a group of remote control codes stored in the storage means in response to a user operation to provide a more user friendly remote control (Column 1, Lines 32-58).

Referring to claims 19, Stenman et al. teaches a mobile telephone with remote-controlling capability which remote-controls target equipment, comprising: an operation unit having a plurality of operation buttons (Column 3, Lines 22-29 and Column 7, Lines 56-63); storage means for storing various remote control codes associated with the plurality of operation buttons in a one-to-one relationship for various controlling operations on the target equipment (Column 3, Lines 30-33 and Column 7, Lines 56-63), and a part of remote control codes of a group of remote control codes for a predetermined controlling operation on the target equipment (Column 3, Lines 30-33); and transmission means for transmitting to the target equipment the a remote control code (Column 7, Lines 49-51) associated with an operation button pressed by a user in advance and the remote control code to perform the predetermined controlling operation on the target equipment in response to a user operation (Column 3, Lines 30-

33 and Column 7, Lines 56-63), Stenman et al. further teaches remotely controlling such devices as TV/VCR (Column 7, Lines 15-21) but does not specifically teach using a group of remote control codes formed by a remote control code associated with an operation button pressed by a user in advance and the part of remote control codes to perform the predetermined controlling operation on the target equipment in response to a user operation. Shim teaches a group of remote control codes formed by a remote control code associated with an operation button pressed by a user in advance and the part of remote control codes to perform the predetermined controlling operation on the target equipment in response to a user operation (Column 1, Lines 32-58). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al. with the teaching of Shim of a group of remote control codes formed by a remote control code associated with an operation button pressed by a user in advance and the part of remote control codes to perform the predetermined controlling operation on the target equipment in response to a user operation to provide a more user friendly remote control (Column 1, Lines 32-58).

Referring to claims 22, 32 and 38, Stenman et al. teaches a mobile telephone with remote-controlling capability which remote-controls target equipment (Column 3, Lines 22-29 and Column 7, Lines 56-63), comprising: an operation unit having a plurality of operation buttons (Column 7, Lines 56-63): storage means for storing various remote control codes associated with the plurality of operation buttons in a one-to-one relationship for various controlling operations on the target equipment (Column 3, Lines

30-33 and Column 7, Lines 56-63), and transmission means for transmitting to the target equipment a remote control code associated with one button of the plurality of operation buttons (Column 7, Lines 49-51) when the one button is pressed and when the mobile telephone is set in a first remote control mode (Column 3, Lines 30-33 and Column 7, Lines 56-63), but does not teach a first group of remote control codes for a predetermined first controlling operations on the target equipment, and a part of a remote control codes of a second group of remote control codes for a predetermined second controlling operation on the target equipment; and transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode, and transmitting to the target equipment the second group of remote control codes pressed by a user in advance and the part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control mode. Shim teaches teach a first group of remote control codes for a predetermined first controlling operations on the target equipment (Column 1, Lines 32-58), and a part of a remote control codes of a second group of remote control codes for a predetermined second controlling operation on the target equipment (Column 3, Lines 58-60 and Column 4, Lines 35-42); and transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode (Column 3, Lines 32-58), and transmitting to the target equipment the second group of remote control codes pressed by a user in advance and the part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control

mode (Column 3, Lines 58-60 and Column 4, Lines 35-42). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al with the teaching of Shim of a first group of remote control codes for a predetermined first controlling operations on the target equipment, and a part of a remote control codes of a second group of remote control codes for a predetermined second controlling operation on the target equipment; and transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode, and transmitting to the target equipment the second group of remote control codes pressed by a user in advance and the part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control mode to provide a more user friendly remote control (Column 1, Lines 32-58).

Referring to claims 29 and 37, Stenman et al. teaches a remote-controlling method for a mobile telephone with remote-controlling capability which remote-controls target equipment (Column 3, Lines 22-29 and Column 7, Lines 56-63), and has an operation unit and storage means for storing various remote control codes associated with a plurality of operation buttons of the operation unit in a one-to-one relationship for various controlling operations on the target equipment (Column 3, Lines 30-33 and Column 7, Lines 56-63), and a part of remote control codes of a group of remote control codes for a predetermined controlling operation on the target equipment (Column 3, Lines 29-33), comprising a step of transmitting to the target equipment a remote control

code formed by the part of remote control codes stored in the storage means (Column 7, Lines 49-51) and a remote control code associated with an operation button pressed by a user in advance to perform the predetermined controlling operation on the target equipment in response to a user operation (Column 7, Lines 56-63), Stenman et al. further teaches remotely controlling such devices as TV/VCR (Column 7, Lines 15-21) but does not teach using a group of remote control codes formed by the part of remote control codes stored in the storage means. Shim teaches using a group of remote control codes formed by the part of remote control codes stored in the storage means. Shim teaches using a group of remote control codes formed by the part of remote control codes stored in the storage means. Shim teaches using a group of remote control codes formed by the part of remote control codes stored in the storage means (Column 1, Lines 32-58). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al. with the teaching of Shim of using a group of remote control codes formed by the part of remote control codes stored in the storage means to provide a more user friendly remote control (Column 1, Lines 32-58).

2. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. and Shim and further in view of August et al. (U.S. Patent No. 5,671,267).

Referring to claim 17, Stenman et al. further teaches wherein the target equipment is a video recording device (Column 7, Lines 16-18), but does not teach the group of remote control codes forms recording information for recording of a program. August et al. teaches the group of remote control codes forms recording information for recording of a program (Column 8, Lines 29-33). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al. and Shim with the teaching of August et al. wherein the group of remote control codes forms recording information for recording of a program to provide remote control and wireless communications in a single device (Column 1, Lines 29-33).

3. Claims 18,21,25,28,31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. and Shim and further in view of Wall et al. (U.S. Patent Publication No. 2003/0156053).

Referring to claims 18, 21,28,31 and 35, Stenman et al. and Shim teach the limitations of claims 18,21,28,31 and 35, but do not teach downloading the various remote control codes associated with the plurality of operation buttons in a one-to-one relationship from a server, which is connected to a communications network, and has the various remote control codes associated with the plurality of operation buttons in a one-to-one relationship, through the communications network, and storing the various remote control codes in said storage means. Wall et al teaches downloading the various

remote control codes associated with the plurality of operation buttons in a one-to-one relationship from a server (0020), which is connected to a communications network (0020), and has the various remote control codes associated with the plurality of operation buttons in a one-to-one relationship (Figure 1), through the communications network (0020), and storing the various remote control codes in said storage means (0023). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Stenman et al and Shim with the teaching of Wall et al of downloading the various remote control codes associated with the plurality of operation buttons in a one-to-one relationship from a server, which is connected to a communications network, and has the various remote control codes associated with the plurality of operation buttons in a one-to-one relationship, through the communications network, and storing the various remote control codes in said storage means so that the remote control device can receive programming via the manufacturers web site (0020).

Referring to claim 25, Stenman et al. and Shim teach the limitations of claim 25, but do not teach wherein each remote control code stored in said storage means is received from a server connected to a communications network through the communications network. Wall et al teaches each remote control code stored in said storage means is received from a server connected to a communications network through the communications network (0020, 0023 and Figure 1). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the

art to combine the teaching of Stenman et al. and Shim with the teaching of Wall et al wherein each remote control code stored in said storage means is received from a server connected to a communications network through the communications network so that the remote control device can receive programming via the manufacturers web site (0020).

4. Claims 20,23,24,27,30,33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al. and Shim and further in view of August et al. (U. S. Patent No. 5,671,267).

Referring to claims 23, 27 and 33, Stenman et al. further teaches wherein the target equipment is a video recording device (Column 7, Lines 16-18), but does not teach the group of remote control codes forms recording information for recording of a program. August et al. teaches the group of remote control codes forms recording information for recording of a program (Column 8, Lines 29-33). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al. and Shim with the teaching of August et al. wherein the group of remote control codes forms recording information for recording of a program to provide remote control and wireless communications in a single device (Column 1, Lines 29-33)

Referring to claims 20,24,30 and 34, Stenman et al. and Shim teach the limitations of claims 20,24,30 and 34, but do not teach wherein the group of remote control codes forms time setting information for setting a time on the target equipment. August et al. teaches wherein the group of remote control codes forms time setting information for setting a time on the target equipment. (Column 8, .Lines 29-33). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al and Shim with the teaching of August et al. wherein the group of remote control codes forms time setting information for setting a time on the target equipment to provide remote control and wireless communications in a single device (Column 1, Lines 29-33).

5. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al in view of Shim and further in view of Wall et al.

Referring to claim 39, Stenman et al. teaches a remote control system, comprising: a mobile telephone with remote-controlling capability which has an operation unit provided with a plurality of operation buttons, and remote-controls target equipment (Column 3, Lines 22-29); wherein said mobile telephone comprises: storage means (Column 3, Lines 30-33 and Column 7, Lines 56-63); and transmission means for transmitting to the target equipment a remote control code associated with one button of the plurality of operation buttons when the one button is pressed and when the mobile telephone is set in a first remote control mode (Column 7, Lines 49-51), but does not teach a first group

of remote control codes for a predetermined first controlling operations on the target equipment, and a part of a remote control codes of a second group of remote control codes for a predetermined second controlling operation on the target equipment; and transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode, and transmitting to the target equipment the second group of remote control codes pressed by a user in advance and the part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control mode. Shim teaches teach a first group of remote control codes for a predetermined first controlling operations on the target equipment (Column 1, Lines 32-58), and a part of a remote control codes of a second group of remote control codes for a predetermined second controlling operation on the target equipment (Column 3, Lines 58-60 and Column 4, Lines 35-42); and transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode (Column 3, Lines 32-58), and transmitting to the target equipment the second group of remote control codes pressed by a user in advance and the part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control mode (Column 3, Lines 58-60 and Column 4, Lines 35-42). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al with the teaching of Shim of a first group of remote control codes for a predetermined first controlling operations on the target equipment, and a part of a remote control codes of a second

group of remote control codes for a predetermined second controlling operation on the target equipment; and transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode, and transmitting to the target equipment the second group of remote control codes pressed by a user in advance and the part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control mode to provide a more user friendly remote control (Column 1, Lines 32-58). Stenman et al and Shim teach the limitations of claim 39, but do not teach a server which is connected to a communications network, and stores various remote control codes associated with the plurality of operation buttons in a one-to-one relationship for various controlling operations on the target equipment, download means for downloading the various remote control codes, the first group of remote control codes, and the part of remote control codes from said server through the communications network, and storing the downloaded codes in said storage means. Wall et al teaches a server which is connected to a communications network (0020), and stores various remote control codes associated with the plurality of operation buttons in a one-to-one relationship for various controlling operations on the target equipment (0020 and 0023), download means for downloading the various remote control codes (0020), the first group of remote control codes, and the part of remote control codes from said server through the communications network (0020), and storing the downloaded codes in said storage means (0023). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to

combine the teaching of Stenman et al and Shim with the teaching of Wall et al teaches a server which is connected to a communications network, and stores various remote control codes associated with the plurality of operation buttons in a one-to-one relationship for various controlling operations on the target equipment, download means for downloading the various remote control codes, the first group of remote control codes, and the part of remote control codes from said server through the communications network, and storing the downloaded codes in said storage means so that the remote control device can receive programming via the manufacturers web site (0020).

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stenman et al, Shim and Wall et al. and further in view of Goldstein.

Referring to claim 40, Stenman et al, Shim and Wall et al. teach the limitations of claim 40, but do not teaches using the same selection for various remote control codes based on a remote control mode. Goldstein teaches using the same selection for various remote control codes based on a remote control mode (Figures 2A - 3B). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Stenman et al, Shim and Wall et al. with the teaching of Goldstein of using the same selection for various remote control codes based on a remote control mode to control a variety of devices (Column 3, Lines 15-17).

(10) Response to Argument

Regarding Appellants argument that Shim does not teach a group of remote control codes for ***one*** operation, this limitation is not claimed in either of claims 16,22,26,32,36,38 or 39. These claims indicate a group of codes for carrying out an operation, which does not support a limitation of a single operation.

Regarding Appellants argument that Shim does not teach that the group of codes are transmitted to ***one*** target apparatus, this limitation is not claimed in either of claims 16,22,26,32,36,38 or 39. These claims indicate remotely controlling target equipment, which does not support a limitation of one target equipment.

Regarding Appellant's argument that Shim does not teach a "group of remote control codes" and that Shim teaches a single code for controlling a single function and does not teach forming a group of remote control codes, which are formed by a remote control code associated with an operation button pressed by a user and part of a remote control codes in response to a user operation, the Examiner disagrees. Shim teaches using a remote controller, which provides the execution of a ***multistage operation*** in accordance with a specific key input (Column 1, Lines 56-58). Shim explains the conventional use of a remote controller and that by pressing a single button on the remote controller provides ***data / remote control code***, corresponding to the key pressed and that when executing more than one operation the user must press the

sequence of buttons required to perform the multistage operation. Shim's invention provides a multistage operation with a single press of a button. With a single press of the button, a plurality of data / remote control codes are executed. The Examiner equates plural data with a group of remote control codes and the single press of the button with a remote control code. Shim states in Column 1, Lines 21-53 that: "A standard remote controller is equipped with a plurality of keys for controlling predetermined operations, and the user's manipulation of each key supplies only one kind of ***data***, corresponding to the key pressed, to initiate a specific function of one appliance..... in the case of a remote controller which controls a video cassette recorder (VCR) and a television, in order to use the VCR, the user must turn on the power of the VCR and then set the television to channel 3 or 4 by means of a channel adjustment key or to a video mode. Accordingly, the keys of the remote controller are manipulated by pressing the keys in the order of; a power key and then a channel 3 key, or the power key and then the video/TV mode conversion key. .....it is an object of the present invention to provide a data transmission method of a remote controller for consecutively supplying a ***plurality of data*** instructions for executing at least two consecutive operations of predetermined apparatus". In addition, figure 3 shows two consecutive operations of pressing a first button and then a second button each operation having a header and control code. Figure 4 shows the multistage operation of pressing one button which creates a single code formed by a group of control codes.

Regarding Appellant's argument that Shim does not teach storing a part of remote control codes of a group of remote control codes. As explained above the multistage operation key is formed of a subset (part) of the entire set (group) of remote control codes. The examiner equates the group as the entire set of remote control codes of each button. The multistage operation button may consist of one, two, three or however many control codes are desired. As shown in figure 1, the buttons are simply switches that go to the controller and the controller stores the codes shown in figures 3 and 4. Nothing in the claim states a user can add certain information to the stored part of remote control codes, such as the hour, day, minute and year, which will correspond to the hour, day, minute and year code prestored in the group.

Regarding the argument that Shim does not teach "transmitting to the target equipment a remote control code associated with one button of the plurality of operation buttons when the one button is pressed and when the mobile station is in a first mode; transmitting to the target equipment the first group of remote control codes in response to a user operation when the mobile telephone is set in a second remote control mode; and transmitting to the target equipment the second group of remote control codes formed by a remote control code associated with an operation button pressed by a user in advance and part of remote control codes in response to a user operation when the mobile telephone is set in a third remote control mode." The Examiner only uses the remote control features of Shim and doesn't claim Shim teaches a mobile telephone. Second the claims do not indicate the user sets the remote control modes or describe

the modes and the Examiner uses the general definition of mode: manner: how something is done or how it happens; a particular functioning condition or arrangement.

The Examiner equates the modes with the functionality of the remote control device. For example, when the remote control is used for a TV and the TV is powered off, the only button on the remote controller that provides an operation is the power button. The examiner equates this with the first mode. In this mode the user selects the power button, which then puts the remote control in a second mode and allows channel, volume and other changes of the TV. In the second mode, the user could select to turn on a certain channel i.e. channel three and turn on the VCR with the multistage operation button which consists of a group of control codes. Shim teaches a combination TV/VCR remote controller which is known to consist of buttons for both remote control of the TV and the VCR. Now that the VCR is on, the buttons for the VCR are functional, putting the remote controller into a third mode. Another multistage operation button consisting of a subset of the entire set of control codes could then be selected to play the VCR in fast-forward. Shim states in Column 3, Lines 58-59 that: "In step S30, it is determined that the key is one which provides plural data instructions" indicating there can be more than one multistage operation key and in Column 4, Lines 35-42 that: "In the above-described embodiment, the turning on of a VCR and the channel selection of a television are given as examples, but the data transmission method of the remote controller according to the present invention can be used to carry out any desired consecutive operations which ordinarily would require key manipulation of the remote controller more than twice."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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